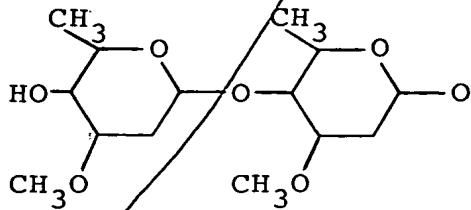


*a'*  
 $R^4$  is H or a 4'-(alpha-L-oleandrosyl)-alpha-L-oleandrosyloxy group of the formula:



with the proviso that when  $R^2$  is alkyl it is not iso-propyl or sec-butyl; [when  $R^4$  is H, each of R and  $R^1$  is H, and  $R^2$  is not methyl or ethyl;] and when  $R^4$  is H, [R is H,  $R^1$  is OH, and]  $R^2$  is not 2-buten-2-yl, 2-penten-2-yl or 4-methyl-2-penten-2-yl.

Claim 13, delete " $R^3$ ", second occurrence, and insert therefor --  $R^2$  --.

R E M A R K S

Entry of the above amendments and reconsideration and withdrawal of the rejection of claims 1-35 and 40 are respectfully requested.

Pursuant to a telephone conversation between the Examiner and a representative of Applicants, the Examiner issued a restriction requirement stating that claims 1-35 and 40 (Group I) are directed to one invention and claims 36-39 (Group II) are directed to a separate and distinct invention. Also pursuant to that telephone conversation, Applicants' representative elected, with traverse, to prosecute the invention of Group I, claims 1-35 and 40. Claims 36-39 presently stand withdrawn from further consideration by the Examiner as being drawn to a nonelected invention.

The Examiner has provisionally rejected claims 1-35 and 40 under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3-5 and 7-9 of copending application Serial No. 279,749.

Claims 1-35 and 40 have been provisionally rejected by the Examiner under the judicially created doctrine of obviousness type double patenting over claims 1, 3-5 and 7-9 of copending application Serial No. 279,749.

The Examiner has rejected claims 33-35 and 40 under 35 U.S.C. 112, first paragraph, stating that the disclosure is enabling only for claims limited in accordance with specific embodiments. The Examiner points to the term "prevention" and argues that the term lacks enablement since the data in the specification supports only treatment of infections. Further the Examiner states that claim 40 lacks enablement since the host has not been set forth.

Claim 13 has been rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite since the terminology " $R^3$  is methyl and  $R^3$  is 3-thienyl" appears therein and there is no antecedent basis for  $R^3$  representing 3-thienyl.

The Examiner has rejected claims 1-3, 13, 17, 28, 33-35 and 40 under 35 U.S.C. 103 as being unpatentable over Mrozik.

Claims 1-3, 13, 17, 28, 33-35 and 40 have also been rejected by the Examiner under 35 U.S.C. 103 as being unpatentable over British patent 2166436 in combination with Mrozik.

Applicants hereby affirm their election to prosecute the invention of Group I, claims 1-35 and 40. Applicants expressly reserve their rights under 35 U.S.C. 120 and 121 to file a division application directed to the subject matter of Group II, claims 36-39. Applicants dispute, however, the Examiner's contention that the products of the process of claims 36-39 can be made by synthetic modification of known avermectin derivatives.

The Examiner's rejection of claims 1-35 and 40 under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3-5 and 7-9 of copending application Serial No. 279,749 is respectfully traversed. Claims 1-35 and 40 are directed to compounds, compositions and methods wherein the compound has an alpha-branched group attached at the C-25 position. As described in the instant specification at page 3, line 26 to page 4, line 1, "[a]lpha-branched means that the carbon atom attached to the 25-ring position is a secondary carbon atom linked to two further carbon atoms." In contrast, claims 1, 3-5 and 7-9 of copending application Serial No. 279,749 are directed to compounds which do not have an alpha-branched carbon attached to the C-25 position.

The Examiner's provisional rejection of claims 1, 3-35 and 40 under the judicially created doctrine of obviousness type double patenting over claims 1, 3-5 and 7-9 of copending application Serial No. 279,749 is respectfully traversed. Claims 1, 3-35 and 40 of this application are patentably distinct from claims 1, 3-5 and 7-9 of application Serial No. 279,749. As discussed above, claims 1, 3-35 and 40 of this application are directed to compounds which have an alpha-branched carbon attached at the C-25 position. Claims 1, 3-5 and 7-9 of application Serial No. 279,749 are directed to compounds which do not have an alpha-branched carbon attached at the C-25 position. The compounds claimed in this application are not within the scope of the compounds claimed in copending application Serial No. 279,749.

The Examiner's rejection of claims 33-35 under 35 U.S.C. 112, first paragraph, has been overcome by Applicants' amendment to the specification at page 9, line 29 and page 10, line 10. Such amendment does not constitute new matter since support for the term "preventing" is found in claims 33-35 as filed and is appropriate. See M.P.E.P. 706.03(n). Claims 33-35 are now enabled by the specification.

The Examiner's rejection of claim 40 under 35 U.S.C. 112, first paragraph, is respectfully traversed.

Claim 40 as written is enabled by the specification wherein it is disclosed that the compounds of this invention are highly active antiparasitic agents having particular utility as anthelmintics, ectoparasiticides, insecticides and acaricides (page 9, line 25 to page 10, line 20). Further, methods of administering the compounds of this invention for such uses are described at page 10, line 21 to page 11, line 25. Claim 40 is fully enabled by the specification. Claim 40 is directed to a method of combatting parasite infections or infestations which comprises contacting the organism responsible for the infection or infestation with an antiparasitic amount of a compound of this invention. Specification of a host for such organisms is not necessary to enable the claim. Claim 40 is enabled as written.

The Examiner's rejection of claim 13 under 35 U.S.C. 112, second paragraph, is overcome by Applicants' amendment to claim 13 hereinabove. The amendment to claim 13 corrects an obvious typographical error and does not constitute new matter. There is antecedent basis for R<sup>2</sup> representing 3-thienyl in claim 1.

The Examiner's rejection of claims 1-3, 13, 17, 28, 33-35 and 40 under 35 U.S.C. 103 as being unpatentable over Mrozik is respectfully traversed. None of the compounds disclosed or claimed in this application

contains a n-propyl or n-butyl group at the C-25 position as contended by the Examiner. As discussed above, compounds of this invention have groups with an alpha-branched carbon atom attached at position C-25. By definition, such groups do not include n-propyl or n-butyl. The compounds of this invention are not obvious in view of Mrozik which discloses certain avermectin compounds having only a methyl, ethyl, sec-butyl or isopropyl group attached at the C-25 position and does not teach, disclose or suggest any of the compounds claimed in this application.

The rejection of claims 1-3, 13, 17, 28, 33-35 and 40 under 35 U.S.C. 103 as being unpatentable over British patent 2166436 in view of Mrozik is respectfully traversed. British patent 2166436 does not teach, disclose or suggest the compounds of this application. Mrozik does not teach, disclose or suggest any process whereby the sugar moiety can be added at the C-13 position of compounds such as those disclosed in British patent 2166436. Neither patent or any combination thereof teaches how to make the compounds claimed in this application. Further, neither patent provides any motivation to combine the teachings thereof.

With respect to the Examiner's above rejections under 35 U.S.C. 103, in the absence of a method of producing the compounds of this invention, such compounds

are not obvious. See In re Hoeksema, 158 U.S.P.Q. 596 (1968), copy enclosed. The Court of Customs and Patent Appeals stated in that case that ". . . the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structure and those of prior art compounds." 168 U.S.P.Q. at 601.

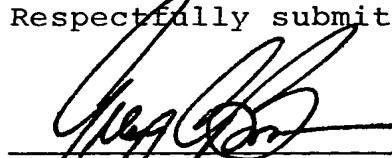
The amendment hereinabove to the Specification at page 1, line 5 is made to reflect the present status of application Serial No. 886,867. One of the amendments to claim 1 removes the proviso that when  $R^4$  is H, each of R and  $R^1$  is H,  $R^2$  is not methyl or ethyl since that proviso is inoperative because  $R^2$  as defined in claim 1 does not equal methyl or ethyl. Such amendment does not add new matter. Further, the proviso that when  $R^4$  is H, R is H,  $R^1$  is OH, and  $R^2$  is not 2-butenyl-2-yl, 2-penten-2-yl or 4-methyl-2-penten-2-yl has been broadened such that when  $R^4$  is H,  $R^2$  is not 2-butenyl-2-yl, 2-penten-2-yl or 4-methyl-2-penten-2-yl. Such amendment decreases the number of compounds within the scope of claim 1 and does not add new matter.

Applicants are filing herewith a Supplemental Information Disclosure Statement together with copies of the cited references for consideration by the Examiner.

PATENT  
PC6947A/6970AGCB

Based on the foregoing, Applicants believe claims 1-35 and 40, all claims presently under consideration, are in condition for allowance and such prompt and favorable action is solicited.

Respectfully submitted,

  
\_\_\_\_\_  
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Date: April 24, 1990  
Enclosure

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M.5a  
(10/10)